

REMARKS/ARGUMENTS

In the communication dated March 9, 2009 the Examiner required the election of a single species. Accordingly, Applicant elects, with traverse, the following:

The components disclosed in Examples 1 or 2, i.e.,

for Component C: mixture of Marlipal 0 13/20 and 100N mineral oil (or alternatively: mixture of Marlipal 0 13/20 and Vestinol OA.

For Component D: water

Essentially all of the pending claims (1-18 and 20) read on the elected “species”.

Applicant requests that should the elected species be found allowable, the Examiner expand the search to include the non-elected species.

Divisional application filed thereafter claiming the non-elected species should not be subject to double-patenting ground of rejection, 35 U.S.C. §121, In re Joyce, (Commr. Pats. 1957) 115 USPQ 412.

The Examiner alleges that the species recited in the specification are patentably distinct. However, the burden of proof is on the Office to provide reasons and/or examples to support any conclusions with respect to patentable distinction (M.P.E.P. §803).

The Examiner has not given adequate reasons and/or examples to support patentable distinctness. Rather, the Office merely stated conclusions. Accordingly, the Office has failed to meet the burden necessary to sustain the election requirement, and the Office has not shown that a burden exists in searching all of the species.

Further, M.P.E.P. §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicant submits that a search of all the claims would not constitute a serious burden on the Office.

Applicant makes no statement regarding the patentable distinctness of the species but note that for the restriction to be proper there must be patentable differences between the species as claimed (M.P.E.P. §808.01(a)).

Applicant's election is for examination only.

Respectfully submitted,

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